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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/838,884	04/20/2001	Mark D. Levitt	103-1345USII	3284

7590 12/15/2004
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EXAMINER

AHMED, SHEEBA

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/838,884

Applicant(s)

LEVITT ET AL.

Examiner

Sheeba Ahmed

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2004 and 01 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/9/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicants response dated September 30, 2004 has been entered in the above-identified application.

Claims 1-35 are pending of which claims 28-35 are now under consideration.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 33-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claim 33 states that a strip agent is applied to "a dried waterborne radiation cured overcoat". It is unclear how the overcoat is both "dried" and "waterborne". Appropriate amendment to clarification is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 33-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Koreltz et al. (WO 94/22965).

Koreltz et al. disclose compositions and methods of using compositions to strip coated surfaces such as finished floors (Page 1, lines 5-10). The compositions are effective in removing multiple coatings of a standard floor sealer/finish comprising urethane/acrylic polymers (Page 3, lines 35-37) and the method of removing the sealer/finish coating from a surface comprising: applying a striper composition to the coating wherein the coating is multiple layers of the same or different compositions **(hence meeting the limitation that the strip agent is applied to a dried radiation cured overcoat which is adhered to a dried intermediate layer atop a substrate)** and allowing the composition to contact the coating for a time sufficient to remove the coating. Preferred methods include abrading the coating (Page 4, lines 1-35). Table I shows the % of coating removed after immersing coated strips in the striper composition for 2.5 minutes and the "% removed" ranges from 67-92%. All limitations of claims 33-35 are disclosed in the above reference.

4. Claims 28-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Bolgiano et al. (US 4,421,782).

Bolgiano et al. disclose flooring materials and a process for making such flooring materials whereby a substrate **(corresponding to the intermediate coating of the claimed invention)** is treated with a solution comprising water, acrylic acid and a surfactant **(corresponding to the overcoat of the claimed invention and meeting**

the limitations that the overcoat is UV curable and comprises an acrylate). Upon irradiating the treated substrate, a tough and durable surface is formed (Column 2, lines 16-23). The substrate may be treated while on an intermediate support surface or when in place on a finished product (Column 3, lines 5-12). The aqueous acrylic acid solution comprises 0.1 to about 75 percent by weight of acrylic acid and from about 0.01 to about 5 percent by weight of a surfactant (Column 3, lines 48-51). The coatings are curable by UV irradiation (see Examples). Examples II states that the coatings were applied to a vinyl-flooring tile. With regards to the limitations that the polymerized top coat is less strippable than the intermediate coating when each is coated atop a vinyl tile when the two coating are coated atop the vinyl tile, the Examiner takes the position that such material property limitations must be inherently met by the coatings taught by Bolgiano et al. given that the chemical composition of the coatings as taught by Bolgiano and that of the claimed invention are identical. All limitations of claims 28-32 are either inherent or disclosed in the above reference.

Response to Arguments

5. The rejection of claims 28-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamrock et al. (WO 98/11168) in view of Holman et al. (US 6,444,134 B1) has been withdrawn. The Declaration under 37 CFR 1.132 filed on July 1, 2004 is sufficient to overcome the above-mentioned rejection particularly given that the Declaration specifically points out that Hamrock et al. teach away from the use of waterborne or aqueous coatings.

Applicant's arguments with respect to claims 33-35 have been fully considered but they are not persuasive. Applicants traverse the rejection of claims 33-35 under 35 U.S.C. 102(b) as being anticipated by Koreltz et al. (WO 94/22965) and submit that the Declaration shows that the tests of Koreltz's stripper using their 2.5 minute dip test do not remove a UV cured overcoat. The Examiner has reviewed the data provided in the Declaration and takes the position that it is unclear how it relates to the rejection of claims 33-35 under 35 U.S.C. 102(b) as being anticipated by Koreltz et al. (WO 94/22965). The basis of the rejection as described in Paragraph 3 above clearly outlines how Koreltz meets the limitations of claims 33 and 35 and the Applicants have failed to clearly point out any distinction between Koreltz's invention and the invention recited in claims 33-35. Hence, this rejection is maintained.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheeba Ahmed whose telephone number is (571)272-1504. The examiner can normally be reached on Mondays and Thursdays from 9:30am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on (571)272-1535. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sheeba Ahmed

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December 12, 2004